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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,999	11/14/2003	Vincent J. Zimmer	42P17569	1567

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EXAMINER

BAE, JI H

ART UNIT	PAPER NUMBER
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2115

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/713,999	Applicant(s) ZIMMER ET AL.	
	Examiner Ji H. Bae	Art Unit 2115	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 13, applicant has recited "a hardware device" in line 2 of the claim. It is unclear whether this hardware device is intended to be the same as that recited in claim 12, or a newly recited hardware device.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-28 recite a series of steps that merely embody an abstract idea. The steps recited by the applicant could have been carried out by a person. Additionally, the steps recited do not appear to produce a result which is useful, concrete, and tangible. Regarding claims 12-28, the fact that the method is recited as being physically embodied (e.g. article of manufacture, machine-readable medium, computer system, flash device) does not necessarily provide cause for considering the method to be statutory subject matter.

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Claims 12-24 recite an article of manufacture comprised of a machine-readable medium. Applicant's specification defines a machine-readable medium to include "propagated signals such as electrical, optical, acoustical or other form of propagated signals (e.g. carrier waves, infrared signals, digital signals etc)." Propagated signals are non-physical media and do not fall within one of the four statutory categories.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 are rejected under 35 U.S.C. 102(e) as being anticipated by Lindeman, U.S.

Patent Application Publication No. 2004/0215950 A1.

Regarding claim 1, Lindeman teaches a method comprising:

requesting to access a hardware device of a computer system during OS runtime of an operating system executing on the computer system [paragraph 8];

finding a pre-boot driver for the hardware device by the computer system [open firmware, paragraphs 4, 37]; and

accessing the hardware device during the OS runtime using the pre-boot driver.

Regarding claim 2, Lindeman teaches a data structure used to advertise the pre-boot driver [partitioned firmware, paragraph 32].

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Regarding claim 3, Lindeman teaches searching for the pre-boot driver in the data structure.

Regarding claim 11, Lindeman teaches loading a pre-boot driver image of the pre-boot driver into a memory device of the computer system during a pre-boot phase of the computer system [paragraph 32].

Regarding claim 12, Lindeman teaches the article of manufacture that implements the method of claims 1-11.

Regarding claim 13, Lindeman teaches initializing a hardware device during the pre-boot phase having stored the pre-boot driver [Fig. 5, step 502].

Regarding claim 14, Lindeman teaches that the hardware device comprises a non-volatile storage device to store the pre-boot driver [paragraph 34].

Regarding claim 18, Lindeman teaches the article of manufacture that implements the method of claims 1-11. Additionally, Lindeman teaches receiving a request from an application executing on the computer system to access a hardware device of the computer system [Fig. 6, step 600].

Regarding claim 25, Lindeman teaches the computer system that implements the method of claims 1-11.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindeman in view of Lee, U.S. Patent No. 6,219,828.

Regarding claim 5, Lindeman teaches the method of claim 1, but does not explicitly teach executing the pre-boot driver image of the pre-boot driver in a pre-boot driver interpreter.

Lee teaches that open firmware boot drivers are encoded in a language called Fcode which executes as part of a virtual machine [col. 1, lines 59-67].

It would have been obvious to one of ordinary skill in the art to combine the teachings of Lindeman and Lee by executing the pre-boot driver image of the pre-boot driver of Lindeman in a pre-boot driver interpreter as taught by Lee. Both Lee and Lindeman are directed towards systems that implement the Open Firmware standard. Lee teaches certain aspects of the Open Firmware standard that are not explicitly taught by Lindeman.

Regarding claims 6 and 22, Lee and Lindeman teach that the pre-boot driver image includes interpreted code to allow management of the pre-boot driver image one opcode at a time.

Regarding claims 15 and 20, Lee and Lindeman teach that the pre-boot driver image comprises an interpreted pre-boot driver image.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Madden et al., U.S. Patent No. 6,996,706 B1;

Rakavy et al., U.S. Patent No. 6,324,644 B1;

Bonola, U.S. Patent No. 5,913,058;

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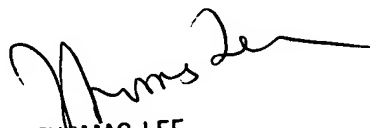
Cardoza et al., U.S. Patent No. 5,630,049;

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ji H. Bae whose telephone number is 571-272-7181. The examiner can normally be reached on Monday-Friday, 10 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Lee can be reached on 571-272-3667. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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